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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,941	04/16/2004	Jorg Diener	3401-141	9025
27799	7590	09/15/2005	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			NGUYEN, TU T	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,941	Applicant(s) DIENER ET AL.	
	Examiner Tu T. Nguyen	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/16/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities:

Claim 1, line 8, "said said pivotable" should be changed to "said pivotable".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatley et al (6,532,840).

With respect to claim 1, Hatley discloses a technoscope for examining an interior wall in a confined space (abstract). The technoscope comprises: a shank 44 (fig 9) having a longitudinal axis and a cross section; a pivotable arm 46 (fig 9) which is pivotably mounted to said shank; and a working device 48 (fig 9) arranged on said pivotable arm.

Hatley does not explicitly disclose said pivotable arm being pivotable from a first position, in which the arm extends in the direction of said longitudinal axis, to a second position, in which the arm extends transversely to the longitudinal axis. However, the claimed limitation would have been obvious according to the rotation arrow 58 (fig 3). It would have been obvious that Hatley's arm 59 (fig 3) is pivotable from a first position, in

which the arm extends in the direction of said longitudinal axis, to a second position, in which the arm extends transversely to said longitudinal axis.

With respect to claim 2, Hatley does not disclose the arm and the working device can be arranged completely within the cross section of the shank. However, it would have been obvious to modify Hatley with the arrangement as claimed to use the system in different environments.

With respect to claim 3, Hatley discloses the claimed arm 46 (fig 9).

With respect to claims 4, 19-20, Hatley does not explicitly disclose a roughness measuring apparatus or a machine tool. However, it would have been obvious to modify Hatley with different measuring apparatuses or a machine tool for measuring different characteristics of the surface. The modification involves only routine skill in the art.

With respect to claims 10-12, Hatley does not explicitly disclose the claimed actuation rod or adjustment wheel or optics. However, it would have been obvious to modify Hatley with the claimed limitations to examine different shape of surfaces.

With respect to claims 13-17, it would have been obvious to modify Hatley with the guide sleeve or the gauge or a flexible arm as claimed to facilitate the examining.

Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatley et al (6,532,840) in view of Winstead et al (5,565,981).

With respect to claim 5, Hatley discloses the working device 48 (fig 3) could be pivotable 62 (fig 3) from the arm 46 (fig 3). However, Hatley does not explicitly disclose the working device being pivotably attached to the arm. Winstead discloses an interior inspection system. The system comprises: a working device 8 (fig 2) being pivotably attached 9 (fig 2) to the arm 4 (fig 2). It would have been obvious to modify Hatley's working device to be pivotably attached to the arm as taught by Winstead to move the working device easier.

With respect to claim 6, Hatley does not explicitly disclose the pivot axis as claimed. however, it would have been obvious to modify Hatley with the claimed pivot axis to use the system in different environment.

With respect to claim 7, since Hatley discloses mounting the working device on the rod 206 (fig 13) and the rod being pivotable at an pivot axis 61 or 62 (fig 3), it would have been obvious that Hatley's working device 48 (fig 3) would have a center of gravity spaced from the pivot axis.

With respect to claim 8, since the rod 206 (fig 13) could be considered as a part of the working device, it would have been obvious that the longitude of the working

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device 206 (fig 13) has a longitudinal axis which is parallel to the longitudinal axis of the shrank 44 (fig 14).

With respect to claim 9, Hatley discloses a working device having a pair of opposite ends 210, 208 (fig 13) and the pivot axis 200 (fig 13) arranged between said ends.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatley et al (6,532,840) in view of Schiler (3,823,482).

With respect to claim 18, Hatley does not disclose a second shrank. Schiler discloses a system comprising: a second shrank 39 (fig 1). It would have been obvious to modify Hatley with a second shrank as taught by Schiler to examine different areas at the same time. Further, refer to discussion in claim 17 above for the flexible shrank.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T. Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Toatley Jr. can be reached on (571) 272-2800 Ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu T. Nguyen
Primary Examiner
Art Unit 2877

09/10/2005